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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/785,093

02/25/2004

Xavier Blin

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FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER  
LLP  
901 NEW YORK AVENUE, NW  
WASHINGTON, DC 20001-4413

EXAMINER

YU, GINA C

ART UNIT

PAPER NUMBER

1611

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/785,093	<b>Applicant(s)</b> BLIN ET AL.	
	<b>Examiner</b> GINA C. YU	<b>Art Unit</b> 1611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 09 January 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-87 and 89-114 is/are pending in the application.
- 4a) Of the above claim(s) 1-77, 103, 104 and 106-113 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 78-102, 105, 114 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                        | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

Receipt is acknowledged of amendment filed on January 1, 2009.

The claim rejection made under 35 U.S.C. § 112, first paragraph, as indicated in the previous Office action dated July 10, 2008, is maintained.

The claim rejection made under 35 U.S.C. § 112, second paragraph, indicated in the same Office action are partly withdrawn in view of applicant's amendment or in view of applicant's remarks in part.

The claim rejections made under 35 U.S.C. §§ 102 (b) and 103 (a) indicated in the same Office action are withdrawn in view of applicant's remarks.

The nonstatutory obviousness double patenting rejections of the same Office action are withdrawn in view of applicant's remarks.

New rejections have been made in view of further search and consideration.

### ***Priority***

Acknowledgment is made of applicant's claim for foreign priority based on an application filed in France on February 25, 2003. It is noted, however, a certified copy of the FR 0350035 application has not been filed.

### ***Claim Objections***

Claim 98 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

***Claim Rejections - 35 USC § 112 (Maintained)***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

**Claims 78-100 and 114 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.**

The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 78-100 and 114 encompass the at least one compounds described only as having a particular solubility parameter and/or a particular molecular mass, which does not adequately correspond to the actually disclosed chemicals in the specification. Only those described in the specification, not the full breadth of the claims meet the written description requirement of 35 U.S.C. § 112, first paragraph. The presently recited “at least one compound” of the rejected claims fails to reasonably convey that applicant was in possession of these compounds.

***Claim Rejections - 35 USC § 103 (New)***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

**Claims 78-81, 83-87, 89-100, 105 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mougin et al. (US 5945095) in view of De La Poterie (US 6238679 B1).**

Mougin teaches a lipstick formulation comprising a) a liquid fatty phase and b) 5 % by weight of a dispersion of polymer particles dispersed therein. Examples 8 and 9 each contains an oil phase and polymer dispersion of Example 1, which is a stable dispersion of 25 % solid content of methyl methacrylate copolymer dispersed in liquid paraffin. The reference teaches the prior art polymers preferably have a molecular weight of about 2000- 10,000,000, and a glass transition temperature of from -100 °C to 300 °C. See col. 4, lines 33-43.

Mougin further suggests adding to the composition a plasticizer when the polymer has too high a Tg for the desired application “so as to lower the Tg of the [polymer] mixture used”, thereby producing composition producing softer film. See Id. The reference teaches using plasticizers “usually used in the field of application”. See Id.

Mougin fails to disclose with sufficient specificity the specific plasticizer compounds.

De La Poterie teaches suitable plasticizers for film-forming make-up products including a lipstick and lip gloss. See col. 3, lines 14 – 29. The reference teaches the plasticizers are chosen from solvents having an average Hansen solubility parameter  $\delta_P$  at 25 °C such that  $\delta_H$  is  $\leq 8 \text{ (J/cm}^3)^{1/2}$ . The preferred plasticizers include dibutyl phthalate ( $\delta_H=7.5$ ;  $\delta_P=2.8$ ), bis(2-ethylhexyl)phthalate ( $\delta_H=5.92$ ;  $\delta_P=1.76$ ), diisopropyl

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adipate,  $\delta_H=7.76$ ;  $\delta_P=2.98$ ), dibutyl adipate ( $\delta_H=7.28$ ;  $\delta_P=2.63$ ); acetyl tributyl citrate ( $\delta_H=7.09$ ;  $\delta_P=1.85$ ). The reference teaches these plasticizers after combination with a film-forming composition remain fluid after storage and are capable of being applied to the support to be treated, such as lips. See Examples.

Given the teaching of Mougin to combine the polymer system with a conventional plasticizer in the application field to modify the mechanical property of the prior art lip compositions, one of ordinary skill in the art would have been obviously motivated to look for prior arts such as De La Poterie for teachings on the specific type of plasticizers used in cosmetic art. Since the latter teaches the specific types of plasticizers suitable for film-forming polymers applicable for lip cosmetic compositions, the skilled artisan would have had a reasonable expectation of successfully producing a stable lip make-up product which does not solidify over time.

With respect to claim 105, although De La Poterie teaches using diisopropyl adipate, the reference also discloses art-recognized functional equivalents that may be substituted in place of diisopropyl adipate. Thus, the selection of other plasticizers disclosed in De La Poterie instead of the plasticizer that is excluded from the present invention would have been an obvious choice, as the skilled artisan would have had a reasonable expectation of successfully producing a composition with similar film properties.

**Claims 78-81, 83-87, 89-100, 105 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ferrari et al. (US 2002/0164297 A1) in view of De La Poterie (US 6238679 B1).**

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Ferrari teaches cosmetic composition for caring for or making up lips comprising a) a liquid fatty phase and b) a dispersion of polymer particles dispersed therein. See abstract. The reference teaches “according to the amount of polymer, it is possible to obtain on . . . the lips a supple, glossy film that covers well while at the time is very comfortable to wear”. See abstract. Example 2 teaches a lipstick formulation comprising 50 % by weight of polymer dispersion of methyl acrylate/acrylic acid copolymer and polystyrene/copoly(ethylene-propylene) diblock copolymer (22-25 % solid content). The suitable polymers also include polyurethanes and polyurethane-acrylics, polyester-polyurethanes, etc. See [0054].

Ferrari further suggests adding to the composition at least one plasticizer compound by indicating that the glass transition temperature of the polymer is adjusted and varied by combining the polymer with plasticizers. See p. 3, [0034-0036]. The reference teaches such modification allows the mechanical properties of the composition to be adjusted as a function of the intended use. For example, the reference teaches to combine the polymer with a high glass transition temperature a plasticizer so as to lower this temperature of the mixture. Modification of the glass transition temperature can be achieved preferably with one of the plasticizers usually used in the application fields concerned. See col. 5, lines 36 – 46.

Ferrari fails to disclose with sufficient specificity the plasticizer compounds.

De La Poterie, discussed above, teaches suitable plasticizers for polyurethane film-forming make-up products including a lipstick and lip gloss. See col. 3, lines 14 – 29. The reference teaches the plasticizers are chosen from solvents having an average

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Hansen solubility parameter  $\delta_P$  at 25 °C such that  $\delta_H$  is  $\leq 8 \text{ (J/cm}^3)^{1/2}$ . The preferred plasticizers include dibutyl phthalate ( $\delta_H=7.5$ ;  $\delta_P=2.8$ ), bis(2-3thylhexyl)phthalate ( $\delta_H=5.92$ ;  $\delta_P=1.76$ ), diisopropyl adipate, ( $\delta_H=7.76$ ;  $\delta_P=2.98$ ), dibutyl adipate ( $\delta_H=7.28$ ;  $\delta_P=2.63$ ); acetyl tributyl citrate ( $\delta_H=7.09$ ;  $\delta_P=1.85$ ). The reference teaches these plasticizers after combination with a film-forming composition remain fluid after storage and are capable of being applied to the support to be treated, such as lips. See Examples.

Given the teaching of Ferrari to combine the polymer system with a conventional plasticizer in the application field to modify the mechanical property of the prior art lip compositions, one of ordinary skill in the art would have been obviously motivated to look for prior arts such as De La Poterie for teachings on the specific type of plasticizers used in cosmetic art. Since the latter teaches the specific types of plasticizers suitable for film-forming polymers applicable for lip cosmetic compositions, the skilled artisan would have had a reasonable expectation of successfully producing a stable lip make-up product which does not solidify over time.

With respect to claim 105, although De La Poterie teaches using diisopropyl adipate, the reference also discloses art-recognized functional equivalents that may be substituted in place of diisopropyl adipate. Thus, the selection of other plasticizers disclosed in De La Poterie instead of the plasticizer that is excluded from the present invention would have been an obvious choice, as the skilled artisan would have had a reasonable expectation of successfully producing a composition with similar film properties.



**Claims 78-87, 89-102, 105, and 114 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ferrari et al. (US 2002/0164297 A1) in view of Simon (US 6080415).**

Ferrari is relied upon as discussed above.

Ferrari fails to disclose with sufficient specificity the plasticizer compounds.

Simon teaches plasticizers suitable for cosmetic make-up products includes tributyl citrate. See col. 12, lines 46 – 65. The functional limitations of the at least one compound of the present claims 78-86, 89-90 are inherently met. The Simon invention is directed to a cosmetic make-up product, comprising first and second components, separately packaged, each containing a cosmetically acceptable medium the first component containing at least one photochromic coloring agent, and at least one second agent containing at least one agent which screens ultraviolet light. See abstract. The make-up products that benefits from the prior art include lip care compositions. See col. 2, lines 40 – 51. The reference teaches the compositions can comprise film forming polymers either dissolved or dispersed in the composition, in an amount ranging from 0-40 %, and preferably 0.5 – 40 %, and most preferably 10-20 % by weight. See col. 12, lines 29 – 45. The polymers include polyurethanes, polyesters, acrylic and/or vinyl types, etc. See Id. The reference teaches up to 30 % by weight of the composition and most preferably 5-10 % of the plasticizers can be used. See col. 12, lines 46 – 55. Among the suitable plasticizers is tributyl acetyl citrate, and diisopropyl adipate is not disclosed in the reference. See claims 102 and 105.

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Given the teaching of Ferrari to combine the polymer system with a conventional plasticizer in the application field to modify the mechanical property of the prior art lip compositions, one of ordinary skill in the art would have been obviously motivated to look for prior arts such as Simon for teachings on the specific type of plasticizers used in cosmetic art. Since the latter teaches the specific types of plasticizers suitable for film-forming polymers applicable for lip cosmetic compositions, the skilled artisan would have had a reasonable expectation of successfully producing a stable lip make-up product with desired modified mechanical properties.

With respect to claim 102, although De La Poterie teaches using tributyl acetyl citrate, the reference also discloses art-recognized functional equivalents that may be substituted in place of this particular plasticizer. Thus, the selection of other plasticizers disclosed in De La Poterie, such as tributyl citrate, instead of the plasticizer that is excluded from the present invention would have been an obvious choice, as the skilled artisan would have had a reasonable expectation of successfully producing a composition with similar film properties.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422

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F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

**Claims 78-102, 105, and 114 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 3-5, 8-64 of copending application no. 10/784,949; claims 1-43 of copending application 11/147, 352; claims 1-57 of copending application 11/147, 318; and claims 1-58 and 62 of copending application 12/004,050; all in view of Simon (US 6080415).**

The inventions of the copending applications are collectively directed to cosmetic compositions comprising film-forming polymer dispersion and at least one liquid oil phase.

The co-pending claims do not require the at least one compounds of the plasticizers of the instant claims.

Simon is relied upon as discussed above. The reference teaches the plasticizers such as tributyl citrate allow the flexibility of the film of polymer to be adjusted without weakening its physical strength and are suitable for cosmetic application. See col. 12, lines 42 – 55.

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It would have been obvious to one of ordinary skill in the art at the time of the present invention to modify the claimed inventions of the copending applications cited above, by incorporating the plasticizers of Simon as motivated by the latter because the reference teaches the plasticizers such as tributyl citrate allow the flexibility of the film of polymer to be adjusted without weakening its physical strength and are suitable for cosmetic application.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed compositions of the copending applications in view of the Simon teaching renders the present composition obvious.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

**Claims 78-102, 105, and 114 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claims 1-62 of copending application 12/004,050; and claims 95-101 and 103-216 of copending Application No. 10/529,318;**

Although the conflicting claims are not identical, they are not patentably distinct from each other because the present claims and the copending claimed are directed to cosmetic compositions of overlapping limitations of at least one liquid fatty phase, a dispersion of at least one polymer particles dispersed in the fatty phase, and at least one plasticizer of the solubility parameters as recited in the present claims.

**Claims 78-102, 105, and 114 rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 4-47 of**

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**U.S. Patent No. 5945095 (Mougin et al. cited above) in view of Simon (US 6080415).**

Mougin claims a cosmetic composition comprising at least one fatty substance and a non-aqueous dispersion of polymer particles in at least one liquid fatty substance.

The Mougin claims do not disclose the specific plasticizer compounds of the instant claims.

Simon is relied upon as discussed above. The reference teaches the plasticizers such as tributyl citrate allow the flexibility of the film of polymer to be adjusted without weakening its physical strength and are suitable for cosmetic application. See col. 12, lines 42 – 55.

It would have been obvious to one of ordinary skill in the art at the time of the present invention to modify the claimed cosmetic composition of Mougin by incorporating the plasticizers of Simon as motivated by the latter because the reference teaches the plasticizers such as tributyl citrate allow the flexibility of the film of polymer to be adjusted without weakening its physical strength and are suitable for cosmetic application.

***Response to Arguments***

Applicant's arguments with respect to claims 78-102, 105, and 114 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GINA C. YU whose telephone number is (571)272-8605.

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The examiner can normally be reached on Monday through Thursday, from 8:00AM until 6:00 PM..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sharmila Landau can be reached on 571-272-0614. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/GINA C. YU/  
Primary Examiner, Art Unit 1611